

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR: ERNEST L. JOHNSON)	
)	
APPLN. NO.: 10/715,584)	GROUP ART UNIT: 3751
)	
FILED: NOVEMBER 18, 2003)	EXAMINER:
)	FETSUGA, ROBERT M.
FOR: AUTOMATIC HAIR WASHING DEVICE)	

Customer No.: 02071
Confirmation No.: 4739

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

REPLY TO OFFICE ACTION

Responsive to the non-final office action mailed in the application on March 13, 2006 (the "Office Action"), Applicant respectfully requests reconsideration of this application in view of the following remarks. The requisite petition for a 3-month extension of time is being filed herewith via the USPTO Electronic Filing System. In support of Applicant's position, submitted herewith is the Supplemental Declaration Under Rule 1.132 of George Moran, P.E. (the "Supplemental Declaration").

Claims 1, 2 and 4-13 are in the case. All of the claims stand rejected on the sole ground that the claims contain subject matter which is allegedly not enabled by the Specification, as required by 35 U.S.C. § 112, first paragraph. Applicant respectfully traverses this rejection for the following reasons.

The Examiner has failed to meet his burden of establishing a *prima facie* case of lack of enablement for the reason that there is no assertion that the level of any experimentation which might be required to practice the claimed invention would be undue experimentation. In the Office Action, the Examiner appears to confirm that this is his position by stating:

. . . a patent disclosure should not require a worker in the art to perform tests or to experiment until a working embodiment is discovered.

Office Action, pg. 3. Yet, in order for a patent claim to meet the enablement standard of section 112, first paragraph, the courts have repeatedly held that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In re Angstadt, 537 F.2d 498, 504, 190 U.S.P.Q. 214, 219 (C.C.P.A. 1976) (also cited in MPEP Section 2164.01). See also In re Geerdes, 180 U.S.P.Q. 789 (C.C.P.A. 1974) (reversing a finding of lack of enablement) and Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 U.S.P.Q. 481 (Fed. Cir. 1984). Clearly, some level of experimentation is not unusual or fatal to the enablement of a claimed invention. As the case law clearly shows and the MPEP confirms, a patent Specification is not supposed to be a manufacturer's product specification, but rather is to be a concise description of the claimed invention sufficient to enable the ordinary skilled artisan to make and use the claimed invention without undue experimentation.

The Examiner further appears to imply erroneously that a different level of teaching is required in a situation where a claim element, used at least in part to distinguish over the prior art, presents a question of enablement. In particular, the Examiner asserts in the Office Action that the claimed rotating nozzle is relied upon for patentability over the prior art, and that therefore the disclosure should teach "one how to make claimed subject matter that is relied upon to distinguish prior art." Office Action, pg. 3. While the Applicant does not necessarily agree with the Examiner's assertions, there is no different or extra level of teaching required to meet the enablement requirement under the first paragraph of section 112 under the asserted circumstance to which the Examiner refers. As is well known, the claims must be examined as a whole, and the central question is whether each claim, viewed as a whole, is enabled by the Specification without the need for undue experimentation. The Examiner also tries to suggest that the Applicant left out details to make the Specification concise. Office Action, pg. 3. Yet, the Applicant has already cited to details in the Specification that do provide sufficient detail to enable those of ordinary skill in the art to make and use the invention without undue experimentation. See Applicant's Response filed January 30, 2006 at pg. 8. Nothing cited by the Examiner establishes otherwise. Thus, in view of all of the foregoing, the Examiner has failed to establish a *prima facie* case of lack of enablement, and this rejection should be reconsidered and withdrawn.

Even if one is to assume, *arguendo*, that the Examiner met his burden to establish a *prima facie* case of lack of enablement, that case has been effectively rebutted by Mr. Moran's declarations, including the Supplemental Declaration filed herewith. These declarations constitute evidence establishing that the Specification is enabling to one of ordinary skill in the art. In reference to Mr. Moran's earlier declarations, the Examiner has asserted that it is "unclear how a mechanical engineer 'highly skilled in the technical field of engineering fluid mechanics' can represent 'one of ordinary skill in the art' as argued." Office Action, page 2. However, Mr. Moran's declarations were and are proffered as evidence of his opinion as to what one of ordinary skill in the art would understand from the present Specification. His opinion was sought because he is someone who is familiar with the technical field and with the skill level of those in the technical field, and has a skill level which is at least equal to that of one of ordinary skill in the art. His original declarations were intended to convey that, in his opinion, a person of "ordinary" skill *in the art* would be enabled by the present Specification to practice the claimed invention. See in this regard paragraph 5 and 9 of the prior declarations of Mr. Moran. The Supplemental Declaration submitted herewith simply clarifies that this was in fact his intention, and further clarifies the level of skill which he believes a person of "ordinary" skill in the art would possess. To suggest that Mr. Moran's declarations would be somehow more persuasive if he were *less* skilled in the art disregards the real significance for which his declarations are submitted, i.e., his opinion regarding the Specification's enablement of those of ordinary skill in the technical field. The Examiner's apparent position that only "ordinary" artisans can submit persuasive declarations on these issues, generally unfairly places applicants in a "catch 22" position, for if it were the actual required legal approach, it would cause applicants to seek only moderately skilled artisans to submit declarations on these sorts of evidentiary issues, with no assurance that such declarants would be accepted by the Office as someone with a sufficient level of skill in the art to render an opinion. Nothing in the applicable law requires that applicants dance to such flying bullets --- guessing the level of skill that an examiner might subjectively believe necessary to achieve an "ordinary" level of skill, and only an "ordinary" level of skill, in a given technical field.

The Examiner further asserts that "the structure of the claimed rotating nozzle has not been shown to be well known." Office Action, pgs. 2-3. Yet, as noted earlier, that is not the test for whether the Specification is enabling. Based upon the Specification's clear disclosure of a rotating

disc and angled holes therein and the other teachings at least at Specification page 5, lines 7-16, it is Applicant's contention that a person of ordinary skill in the art to which this invention pertains would be quite capable of making and using the claimed invention, with little or no experimentation, and that even if experimentation were required, it would clearly not be *undue* experimentation. Thus, even if a *prima facie* case of lack of enablement were somehow established by the Examiner, it has been effectively rebutted by the Applicant.

Accordingly, the rejection of claims 1, 2 and 4-13 under section 112, first paragraph, is not well founded and should be reconsidered and withdrawn.

Favorable action and the allowance of all of the claims in this case is solicited. If there are any issues remaining which might be resolved through a conference with the undersigned, the Examiner is invited to contact the undersigned to determine if the issues can be addressed and promptly resolved.

Respectfully submitted,

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